

GOGGINS, Timothy P.

USSN: 10/754,398

REMARKS/ARGUMENTS

Claims Rejections Under Section 112

Claims 21 and 22 were rejected under 35 U.S.C. 112. These claims have been amended, and thus, the rejection is now believed to be moot.

Claims Rejections Under Section 102

Claims 1, 2 4-6, 9, 10 and 12 were rejected under 35 U.S.C. 102(a) as being unpatentable over Goggins (U.S. Patent 5,896,230).

With regard to Claim 1, at pages 2-3 of the Office Action, the Examiner indicates that "Goggins is interpreted as disclosing a digitally imaged lenticular product having a special effect feature, the products comprising ... a digitally (col. 1, line 37) output interlaced image including a special effect feature...". Applicant respectfully submits that the Examiner's interpretation is incorrect.

Claim 1 requires that the digitally imaged lenticular product include a *digitally output* interlaced image. While Goggins teaches a method(s) associated with interlaced images, no particular type of output (e.g., printing) is specified or described in detail. As the Examiner notes, Goggins does disclose (in the Background section) that "[w]here the first images were created by hand, today the images can be created by one or more of a wide variety of techniques, e.g., photographic, chemical etching, computer-controlled optical scanning and engraving, digital at, and the like".¹ Here, Goggins is describing that interlaced images, *prior to output* to a lenticular lens, can be in the form of digital art.

Goggins goes on to teach that interlaced images can then be output, indicating that "[t]he composite image can be outputted to any high-resolution outputting device which can eventually create a lithographic separation, e.g., a film, proof, etc.... This separation can then be used to create the print to which the lenticular lens can be laminated by any conventional technique." (Col. 6, lines 62-67). Goggins, does not describe in any particular fashion the manner in which interlaced or composite images can be output, except to the extent that the device is a "high resolution outputting device".

Stated another way, while Goggins does not exclude the potential for a digitally output interlaced image (e.g., via printing in a digital environment). However, Goggins does not explicitly state that digital printing is utilized or in some way required.

¹ Applicant notes that "digital 'at'" should in fact read "digital art".

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Moreover, a digital output is not inherent since it is clear from the teachings of Goggins that digital printing is not necessarily or inevitably required to accomplish the preparation of a multidimensional image as described in the reference cited. Thus, digital output is not required.

It is noted that inherency of an undisclosed element can only be established by showing that "the inherency is necessary and inevitable" and not merely possible or even probable. Interchem. Corp. v. Watson, 111 U.S.P.Q. 78, 79 (D.D.C. 1956), *aff'd*, 116 U.S.P.Q. 119 (D.C. Cir. 1958); MPEP § 2112.

Applicant notes that there are a number of specific benefits associated with the output of an interlaced image in a digital environment, several of which are set forth by the Applicant in the detailed description of the invention. For example, at page one of the Specification, and more specifically at lines 2-8, the Applicant indicates that digital printing allows for "specific benefits ... in the cost and press time efficiencies associated with the production of make-ready samples, offline plate imaging, availability of 'want one, print one' low press run viable capabilities, reduction of press operators, increasing sheet per hour production, individual variability without changing output rate, increasing quality of the press proofs, among others." The advantages described here are carried forward when digital printing is applied to lenticular images, that is, digitally output interlaced images.

Accordingly, for at least the reasons noted above, Claim 1 is believed to be allowable in view of the teachings of Goggins, and thus, the allowance of Claim 1 is respectfully requested.

Claim 9, which includes the recitation "digitally output interlaced image", was also rejected in view of Goggins. Claim 9 is believed to be allowable for at least the reasons noted above in support of Claim 1.

Claims that depend from independent claims include the recitations of those independent claims from which they depend. Claims 2 and 4-6 depend from Claims 1, and Claims 10 and 12 depend from Claim 9. Accordingly, Claims 2, 4-6, 10 and 12 are allowable for at least the reasons noted above in support of Claims 1 and 9.

Claims Rejections Under Section 103

Claims 15, 16, 18, 19, and 22-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Goggins (U.S. Patent 5,896,230).

For the reasons noted above in support of Claims 1 and 9, Goggins does not teach, let alone suggest the invention of independent Claim 15. Moreover, Claims 16, 18, 19, and 22-

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25 depend from Claim 15. Thus, these are believed to be allowable for at least the reasons noted in support of the allowability of Claim 15.

Furthermore, with respect to inherency, the Examiner has failed to show that the undisclosed element must be present in the prior art reference. As stated before, an undisclosed element can only be established by showing that the inherency is necessary and inevitable and not merely possible or even probable. Interchem. Corp., 111 U.S.P.Q. at 79; MPEP § 2112. In addition, inherency and obviousness are distinct concepts. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 314 (Fed. Cir. 1983). In order to establish a *prima facie* case of obviousness based on inherent properties, the Examiner must show that the undisclosed properties are not only inevitably and necessarily present, but also that the inherency of the undisclosed properties or elements is obvious to one skilled in the art. Kloster Speedsteel AB v. Crucible Inc., 230 U.S.P.Q. 81, 88 (Fed. Cir. 1986).

For at least these reasons, Claims 15, 16, 18, 19, and 22-25 are believed to be allowable, and thus, the rejection of these claims should be withdrawn.

Claims 3, 8, 11, 14, 17, and 21 were rejected as being unpatentable over Goggins (US Patent 5,896,230), as applied to claims 1, 9 and 15, in view of Raymond (US 6,781,761).

Claims 1, 9 and 15 are allowable for at least the reasons noted above. Accordingly, Goggins – whether taken along or in combination with Raymond – does not teach, let alone suggest the subject matter of Claims 3, 8, 11, 14, 17, and 21. Thus, these claims are believed to be allowable as currently presented.

Here again with respect to inherency, the Examiner has failed to show that the undisclosed element must be present in the prior art reference(s).

For at least these reasons, Claims 3, 8, 11, 14, 17, and 21 are believed to be allowable and thus, the rejection of these claims should be withdrawn.

Conclusion

The Applicants believe that the amendment of the claims, along with the above comments, puts the application in condition for allowance.

A two-month extension fee of \$225.00, which is believed due at this time, is attached. Such fee should be charged to Deposit Account 23-2053. No other fee is believed due. Any required petition should be considered provisionally made.

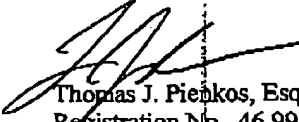
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The Examiner is invited to contact the undersigned should further action be deemed necessary in this case.

Respectfully submitted,

Dated: March 17, 2005
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